

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 26

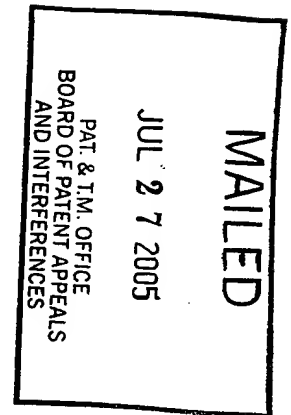
UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte DENISE E. SMITH and
CHRISTOPHER A. GUTIERREZ

Appeal No. 2005-1182
Application No. 09/611,196

ON BRIEF



Before KRASS, OWENS, and MacDONALD, *Administrative Patent Judges.*
OWENS, *Administrative Patent Judge.*

DECISION ON APPEAL

This appeal is from the final rejection of claims 1-4 and 6-30, which are all of the pending claims.

THE INVENTION

The appellants claim a multipurpose card and a system, method and computer readable medium for making the card.

Claim 1, which claims the card, is illustrative:

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1. A multipurpose calling card comprising:
 - a calling card portion; and
 - a key ring portion, the key ring portion being separable from the calling card portion,
- wherein a size of the multipurpose calling card is approximately a size of a conventional calling card.

THE REFERENCES

Small	5,513,117	Apr. 30, 1996
Holstrom	5,570,081	Oct. 29, 1996
Taskett	5,684,291	Nov. 4, 1997
MacWilliams et al.	6,385,860	May 14, 2002
(MacWilliams)		(filed Mar. 1, 2002)

THE REJECTIONS

The claims stand rejected under 35 U.S.C. § 103 as follows:
claims 1, 3, 4, 6-11, 13, 14, 16-19, 21, 22, 24, 28 and 29 over
Holstrom in view of Taskett; claim 2 over Holstrom in view of
Taskett and Small; claims 7, 12, 15, 16, 20, 22, 23 and 25-27
over Holstrom in view of Small; and claim 30 over Holstrom in
view of Taskett and MacWilliams.

OPINION

We affirm the rejections of claims 1-4 and 6-29, and reverse
the rejection of claim 30.

Claims 1-4 and 6-29

The appellants' claims 1-4 and 6-29 require a card portion and one of a key ring, key tag or hole-containing portion, at least one of the portions having printed matter thereon. The printed matter can be card portion information for placing a call (claims 1, 3, 4, 28 and 29), key ring portion promotional information, personal expressions or photographs (claim 2), card portion and key ring portion identification number information for placing a call (claim 6), key tag portion personal information (claims 7 and 8), main portion or key tag portion information for placing a prepaid call (claim 9), main portion or key tag portion information for buying a gift (claim 10), main portion or key tag portion information for buying on credit (claim 11), main portion or key tag portion information showing at least one of a company logo, a personal expression and a photograph (claim 12), main portion and key tag portion personal information (claim 13), main portion and key tag portion identification number information (claim 14), main portion or key tag portion information specified by a user (claim 15), main portion and key tag portion customizing information (claims 16-18 and 22), main portion or key tag portion information for placing a call, buying a gift or buying on credit (claim 19), main

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portion and key tag portion information showing at least one of a company logo, a personal expression and a photograph (claims 20 and 23), main portion and key tag portion identification number information (claims 21 and 24), main portion and key tag portion personalized information (claims 25 and 26), and main portion and key tag portion information for placing a call, buying a gift or buying on credit (claim 27).

Holstrom discloses a two-piece detachable card, one piece of which has a hole therein (figures 1 and 2). Holstrom's card differs from that of the appellants in that the printed matter on Holstrom's card is lost article tracking information (col. 2, lines 41-43) rather than the types of information, i.e., calling card information, promotional information, etc., required by the appellants' claims.

Our reviewing appellate courts have held that for printed matter to distinguish a claimed invention over prior art, there must be a new and unobvious functional relationship between the printed matter and the substrate on which it appears. See *In re Ngai*, 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004); *In re Gulack*, 703 F.2d 1381, 1386, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Miller*, 418 F.2d 1392, 1396, 164 USPQ 46, 49 (CCPA 1969).

The appellants' claims do not require such a functional relationship. The card portion required by the claims is merely a substrate that supports printed matter having the content required by each claim, i.e., call making information, promotional information, personal expressions, etc. Consequently, the printed matter required by the appellants' claims does not patentably distinguish the claims over Holstrom.

The appellants argue that Holstrom does not disclose that the card is approximately the size of a conventional calling card (brief, pages 8-9). Holstrom's disclosures that the base portion (10) is placed in a secure place which can be a wallet (col. 3, lines 7-8) and is made of flexible plastic similar in scope to a credit card (col. 2, lines 49-51) would have fairly suggested, to one of ordinary skill in the art, a card thickness and size equal to those of a credit card, which is approximately the size of a conventional calling card.

The appellants argue that claim 29 requires 5-6 perforations between the first and second portions (brief, page 19). Holstrom teaches that the base (10) and tag (12) are detachable by snapping them apart at a groove (16) between them (col. 2, lines 54-55; figure 1). Taskett's disclosure that card portions can be separated by dotted, perforated or other suitable

separating mechanisms (col. 7, lines 21-23) would have fairly suggested, to one of ordinary skill in the art, separating Holstrom's card portions either by Holstrom's groove or by one of the separating mechanisms disclosed by Taskett such as perforations, with the number of perforations, such as 5 or 6, required to separate the card portions being determined through no more than routine experimentation.

For the above reasons we are not convinced of reversible error in the rejections of claims 1-4 and 6-29. Accordingly, we affirm the rejections of those claims.

Claim 30

Claim 30 requires placing a label on a perforation between first and second card portions. The purpose of the label is to prevent unintentional separation of the two card portions (specification, page 6, lines 12-14).

The examiner argues (answer, page 10):

Regarding claim 30, The [sic] combination fails to teach the claimed subject matter but MacWilliams teaches a label and method for applying in (see fig. 1) wherein a label can be placed on perforation to protect the perforated means in (see figs. 1, 5 and disclosure).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate this teaching into that of the primary references as means of providing a label

covering the two-piece perforated piece for protection purposes.

MacWilliams places a label over a perforation to permit half of a backing member to be peeled from the label at a time so that half of the label at a time can be applied to the top of a file folder (col. 3, lines 33-36 and 46-51; col. 4, lines 9-10 and 38-62). The examiner has not pointed out any disclosure by MacWilliams of applying a label to a perforation to protect the perforation, and we are forbidden from using common sense unsupported by evidence of record to arrive at the conclusion that it would have been obvious to one of ordinary skill in the art to place a strip over a perforation between two pieces to strengthen the perforation until the desired time for separating the pieces at the perforation. See *In re Lee*, 277 F.3d 1338, 1345, 61 USPQ2d 1430, 1435 (Fed. Cir. 2002) and *In re Zurko*, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). Consequently, we reverse the rejection of claim 30.

DECISION

The rejections under 35 U.S.C § 103 of claims 1, 3, 4, 6-11, 13, 14, 16-19, 21, 22, 24, 28 and 29 over Holstrom in view of Taskett, claim 2 over Holstrom in view of Taskett and Small, and

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claims 7, 12, 15, 16, 20, 22, 23 and 25-27 over Holstrom in view of Small, are affirmed. The rejection under 35 U.S.C § 103 of claim 30 over Holstrom in view of Taskett and MacWilliams is reversed.

AFFIRMED-IN-PART


ERROL A. KRASS
Administrative Patent Judge

Terry J. Owens
TERRY J. OWENS
Administrative Patent Judge

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AND
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ALLEN R. MacDonald
Administrative Patent Judge

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